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Shaun Puckrin

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EXAMINER

CHOY, PAN G

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/596,582	<b>Applicant(s)</b> PUCKRIN, SHAUN	
	<b>Examiner</b> PAN CHOY	<b>Art Unit</b> 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-7, 11-18 and 24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 11-18 and 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Introduction***

1. The following is a non-final office action in response to communications received on March 23, 2010. Claims 1 and 24 have been amended; Claims 8-10 and 19-23 have been cancelled.

Currently claims 1-7, 11-18 and 24 are pending.

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 23, 2010 has been entered.

### ***Response to Arguments***

2. Applicants' arguments filed on 01/22/2010 have been fully considered but they are not persuasive.

3. In the Remarks on page 6, Applicant argues regarding Claims 1 and 24, that the references of Fitzpatrick and Cordery fail to teach or suggest "generate digests of the

contacts in the respective contacts stores and to only transfer the digests between devices to enable discovery of common contact”.

In response to Applicant’s arguments, the Examiner respectfully disagrees; Cordery clearly discloses “the generation within each individual metering device of a key pair consisting of a private key” (see col. 1, line 35), and “This object is met by providing a method for transmitting a key from a first device to a remotely located second device via the steps of generating the key within the first device” (see col. 2, line 18-29). See also Fig. 2, item S7, and col. 4, lines 56-59.

Further, Applicant stated “none of the prior art teaches or suggests normalized the contract entries in digests”; however, Applicant’s argument is directed to the newly amended claims, which have been fully addressed in the updated rejection.

4. From the last paragraph on page 6 to page 8, Applicant disagrees that “The Office asserted that Cordery, with its teaching of transmitting keys from a postage metering device to a remote data center, renders the claimed invention obvious under 35 U.S.C. § 103(a) when combined with the teachings of Fitzpatrick.” And “nothing in Fitzpatrick, discusses, mentions, or indicates and need or desire to generate digests of the contacts in the respective contacts stores and to only transfer the digests between devices to enable discovery of common contacts, nor does Fitzpatrick contain any teaching or suggestion of normalizing the contacts.

In response to Applicant’s arguments, the Examiner respectfully disagrees; the invention of Cordery is transmitting keys (hash value or digests) between postage

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metering devices, in another word, it is transmitting secure and trust data between two devices; and the invention of Fitzpatrick is to provide a method and system through which a user can identify other users have common contacts, in order to identify a user from another device have common contact, it has to send and receive communication between both devices, how to be sure the communication between the two devices are safe and trustable? One of ordinary skill in the art would know by using **Hash Key or digests** to securely transmitting data between the two devices as taught by Cordery. Fitzpatrick does not explicitly disclose generating hash key or digests of the contact data, however, Fitzpatrick discloses "the present invention can be used to promote collaboration between parties by fostering trust when they discover one or more common contacts known and trusted by each party" (see ¶ 6), before handshake (see Fig. 5). Therefore given the broadest reasonable interpretation to one of ordinary skill in the art, using hash key or digests would be the promoted solution.

### ***Claim Objections***

2. **Claim 1** is objected to because of the following informalities. Applicant claiming claim 1 as a method; however, the steps in claim 1 recite "**causing** a function to be performed" appear to be a software product such as a readable medium contains instruction code, when executing by a computer, causing the function to be performed. Clarification is required.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-5, 11-18 and 24** are rejected under 35 U.S.C. 103(a) as being unpatentable over (U.S. Pub. No.: 2003/0036914) to Fitzpatrick et al., (hereinafter: "Fitzpatrick"), and in view of (U.S. Pat. No.: 6480831) to Cordery et al., (hereinafter: "Cordery"), and further in view of (U.S. Pub. No.: 2004/0255125) to Hasegawa.

**Regarding Claim 1**, Fitzpatrick discloses a method of operating a computing device (see Abstract and ¶ 6: *computing devices*) which enables the communication of information between the device (see Abstract, Fig. 1, and ¶ 7: *first computing device*) and a further computing device (see Abstract, Fig. 1, and ¶ 7: *second computing device*), each having a communications capability (see ¶ 7: *receiving communication; local communication, or wireless communication*; and ¶¶ 23-25), the method comprising:

causing the device to request information regarding contact entries in a contact store of the further device (see ¶ 29: *search the contact lists corresponding to each person identified in message 225 for common contacts*; and ¶ 4);

notifying at least one of the devices of contacts determined to be common to the contact stores of the devices (see ¶ 8: *the second computing device can provide notification to the second user that another user has at least one common contact, and the first computing device can provide notification to the first user that another user has at least one common contact*);

Fitzpatrick does not explicitly disclose the following limitations; however, Cordery discloses:

causing a hash key to be transmitted to the further device (see col. 2, lines 18-29);

causing the devices each to generate digests of contact entries in their respective contact stores using the hash key (see col. 3, lines 57- col. 4, lines 67);

causing the digests generated by the further device to be transmitted to the device (see Fig. 3, and col. 1, lines 33-35, col. 2, lines 18-29, and col. 4, lines 4-7), said digests including normalized versions of said contact entries; and

using the digests to compare the contact entries of the respective contact stores (col. 5, lines 14-15). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the features as taught by Cordery in the system of Fitzpatrick, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Fitzpatrick and Cordery do not explicitly disclose said digests including normalized versions of said contact entries; however, Hasegawa discloses "a message digest process is executed for a bit stream, which includes a plurality of standardized structural data, and a bit stream in which the additional information..." (see ¶¶ 98-101). It would have been obvious to one of ordinary skill in the art at the time of the invention to include standardize the contact data as taught by Hasegawa in the system of Fitzpatrick, and in view of Cordery, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**Regarding Claim 2**, Fitzpatrick in view of Cordery and Hasegawa discloses all the limitations as described above. Fitzpatrick further discloses wherein the contact store of the device and/or the contact store of the further device is/are arranged as a plurality of overlapping or exclusive groups of contact entries (see ¶ 38: *a person's contact list can be marked private or non-public*).

**Regarding Claim 3**, Fitzpatrick in view of Cordery and Hasegawa discloses all the limitations as described above. Fitzpatrick further discloses wherein contact entries in the contact store of the device and/or the contact store of the further device are selectively excluded from the comparison of contact entries (see ¶ 38: *the contact marked as private or non-public would not be compared to another's contact list in determination of common contacts*).



**Regarding Claim 4,** Fitzpatrick in view of Cordery and Hasegawa discloses all the limitations as described above. Fitzpatrick further discloses wherein at least one of the groups is selectively excluded from the comparison of contact entries (see ¶ 38: *a contact marked as private or non-public would not be compared to another's contact list in determination of common contacts*).

**Regarding Claim 5,** Fitzpatrick in view of Cordery and Hasegawa discloses all the limitations as described above. Fitzpatrick further discloses wherein the contact entries are selected to comprise telephone numbers (see ¶ 29: *the contact clearing house can compare additional features such as telephone numbers*).

**Regarding Claim 11,** Fitzpatrick in view of Cordery and Hasegawa discloses all the limitations as described above. Cordery further discloses wherein a network server is arranged to generate the hash key and communicate it to the devices (see col. 2, lines 18 -29).

**Regarding Claim 12,** Fitzpatrick in view of Cordery and Hasegawa discloses all the limitations as described above. Fitzpatrick further discloses wherein the comparison of contact entries is undertaken by one of the computing devices using data communicated to it by the other (see ¶ 35: *each PCD can include a computer program for sending and receiving another person's contact information as well as for comparing that information to locally stored contact information*).

**Regarding Claim 13**, Fitzpatrick in view of Cordery and Hasegawa discloses all the limitations as described above. Fitzpatrick further discloses wherein the comparison of contact entries is undertaken by a network server (see ¶ 20: *the contact clearing house can be implemented as one or more computer programs existing within a computer system (server); and ¶ 29: the contact clearing house can receive the message and search the contact lists corresponding to each person identified in the message for common contacts, and the corresponding contact list can be compared. The contact clearing house can compare additional features such as the contact category, i.e., business or personal, address, e-mail address, telephone numbers, and the like*).

**Regarding Claim 14**, Fitzpatrick in view of Cordery and Hasegawa discloses all the limitations as described above. Fitzpatrick further discloses wherein the contacts store accessible by the device and the contacts store accessible by the further device are held respectively on the device and the further device (see ¶ 21: *The contact clearing house can include contact information corresponding to participating users, the contact information can be stored electronically in the form of contact list uploaded from the Portable Computing Devices*).

**Regarding Claim 15**, Fitzpatrick in view of Cordery and Hasegawa discloses all the limitations as described above. Fitzpatrick further discloses wherein the contacts store of the device and the contacts store of the further device are held by a third party

(see ¶ 21: *The contact clearing house can be operated by a trusted third party to ensure data integrity and accuracy*).

**Regarding Claim 16**, Fitzpatrick in view of Cordery and Hasegawa discloses all the limitations as described above. Fitzpatrick further discloses wherein the third party comprises the network server (see ¶ 20: *the contact clearing house can be implemented as one or more computer programs existing within a computer system*).

**Regarding Claim 17**, Fitzpatrick in view of Cordery and Hasegawa discloses all the limitations as described above. Fitzpatrick further discloses wherein communication between the device and further device occurs over a wireless link (see ¶ 7: *communication can be a wireless communication*).

**Regarding Claim 18**, Fitzpatrick in view of Cordery and Hasegawa discloses all the limitations as described above. Fitzpatrick further discloses wherein the wireless link comprises any one or more of a cellular phone network, infrared, Bluetooth or a 802.11 WiFi network (see ¶ 7: *a infrared wireless communication, satellite or cellular*; ¶ 20: *a non-local wireless communications link such as cellular or a satellite communication link*).

**Regarding Claim 24**, claim 24 recites similar limitations to Claim 1 and is therefore rejected using the same art and rationale as applied in the rejection of Claim 1.

5. **Claims 6-7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Fitzpatrick and in view of Cordery and Hasegawa as applied to claim 1 above, and further in view of (U.S. Pat. No.: 44390981 A) to Wood et al., (hereinafter: "Wood").

**Regarding Claim 6**, Fitzpatrick, Cordery and Hasegawa do not explicitly disclose wherein selected characters are removed from the telephone numbers; however, Wood in an analogous art of "Microprocessor controlled message handling system" teaches "a phone number may be typed with interspersed non-digit characters, these characters are removed from the number, and do not appear when the phone number is displayed" (see col. 14, lines 63-66). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the features as taught by Wood in the system of Fitzpatrick, and in view of Cordery and Hasegawa, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**Regarding Claim 7**, Fitzpatrick, Cordery and Hasegawa do not explicitly disclose wherein the telephone numbers are arranged to comprise a country or area code; however, Wood discloses a local phone number (408) 736-7320 including area code (408) (see col. 14, line 67). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the features as taught by Wood in the system of Fitzpatrick, and in view of Cordery and Hasegawa, since the claimed invention is

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merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Burr (U.S. Pat. No.: 7177594 B2) discloses a method of establishing a mobile ad hoc network between a plurality of wireless mobile device that have common contacts on their contact lists, determining mutual common contacts of the predetermined contact lists, and enabling a request for communicate over a telephone network.
- Nonogaki et al., (U.S. Pub. No.: 2003/0093552) discloses a data communication system including a storing device which stores a pre-shared key and a Hash function which are jointly owned in the client terminal, a receiving device for receiving a predetermined data and a first Hash value.
- Rouse et al., (U.S. Pub. No.: 2002/0087620 A1) discloses a system and method for communication between mobile devices and enabling user to access information using mobile device over wireless data networks.

- Match-Maker for Mobile Phone, FTXT.com, M2 Presswire, Coventry, August 1, 2002; discloses an easy and convenient way of meeting new people by using mobile phones.
- “Wearable Security Services”, by Jalal Al-Muhtadi et al., Department of Computer Science, University of Illinois at Urbana-Champaign, 2000. A method enables a wristwatch and other portable devices to communicate securely between each other within an active space comprising a public/private key pair. When a user decides to communicate with some device and employs the DH Key exchange protocol, a unique session key can be established between the wristwatch and the device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pan Choy whose telephone number is (571)270- 7038. The examiner can normally be reached on Mon-Fri, 8:30AM - 6:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynda Jasmin can be reached on (571) 272-6782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business

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Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO

Customer Service Representative or access to the automated information system, call

800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pan Choy/

Examiner, Art Unit 3624

August 27, 2010

/Scott L Jarrett/

Primary Examiner, Art Unit 3624